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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/511,445	02/22/2000	William J. Gordon-Kamm	1115	1983

7590                    12/04/2001  
Pioneer Hi-Bred International Inc  
Corporate Intellectual Property  
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EXAMINER

COLLINS, CYNTHIA E

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 12/04/2001

10

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/511,445	GORDON-KAMM ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Cynthia Collins	1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 September 2001.

2a) This action is **FINAL**.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3-7 and 9-12 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,3-7 and 9-12 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

1. The Amendment filed September 24, 2001, paper no.7, has been entered.
2. The specification has been amended on page 3 line 6.
3. Claims 2 and 8 have been cancelled.
4. Claims 1, 3, 7 and 9 have been newly amended.
5. Claims 1, 3-7 and 9-12 are pending.
6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Priority***

7. The Examiner acknowledges Applicant's assertion that a foreign priority is claimed. However, The Examiner observes that the only priority claimed on page 1 of the declaration and page 1, lines 14-17 in the specification is a priority under 35 USC 119 to US Provisional Application Serial No. 60/124,136.

***Information Disclosure Statement***

8. An initialed and dated copy of Applicant's IDS form 1449, Paper No. 9, is attached to the instant Office action.

***Specification***

9. The objection to the disclosure is withdrawn in light of Applicant's amendment on page 3 line 6 of the specification.

***Claim Rejections - 35 USC § 112***

10. The rejection of claims 7-12 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art

to which it pertains, or with which it is most nearly connected, to make and/or use the invention, is withdrawn in light of Applicant's 1.132 Declaration.

11. The rejection of claim 1 under 35 U.S.C. 112, second paragraph, as being indefinite because it is unclear whether the promoter is driving expression in the target cell, or driving expression in an isolated viral replicase polypeptide, is withdrawn in light of Applicant's amendment of claim 1.

12. Newly amended claim 7, and newly amended claim 9 and original claims 10-12 dependent thereon, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Regarding newly amended claim 7, the phrase "growing the transformed plant cell under conditions sufficient to produce a regenerated plant having cells exhibiting increased endoreduplication" renders the claim indefinite because it is unclear what those conditions would be.

***Claim Rejections - 35 USC § 102***

14. The rejection of claims 7-8 and 10-11 under 35 U.S.C. 102(e) as being anticipated by Gronenborn is withdrawn in light of Applicant's amendment of claim 7.

15. Newly amended claims 1 and 3 are rejected, and original claims 4-6 remain rejected, under 35 U.S.C. 102(e) as being anticipated by Gronenborn, for the reasons of record set forth in the previous office action.

16. Applicant argues that the invention of Gronenborn differs from the instant invention because Gronenborn discloses mutating RepA as a viral resistance mechanism, and because Gronenborn relates to transgenic plants that are resistant or tolerant to pathogenic DNA viruses, whereas the

instant invention provides novel methods for modulating endoreduplication through transgene manipulation.

17. Applicant's arguments have been fully considered but they are not persuasive.
18. Newly amended claims 1 and 3 and 4-6 do not recite any specific limitations that clearly teach over the prior art of Gronenborn. The claims do not elucidate what Applicant did differently from Gronenborn.
19. Accordingly, Applicant's arguments are not persuasive.

***Claim Rejections - 35 USC § 103***

20. The rejection of claims 1-12 under 35 U.S.C. 103(a) as being unpatentable over Gronenborn in view of Grafi et al. is withdrawn in light of Applicant's assertion that the references do not teach increasing crop yield by increasing endoreduplication, and that there is inadequate motivation to combine the references.

***Conclusion***

21. Claims 1, 3-7 and 9-12 are rejected.
22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell can be reached on (703) 308-4310. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and 1 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CC  
November 30, 2001

ELIZABETH F. McELWAIN  
PRIMARY EXAMINER  
GROUP 1600

*Elizabeth F. McElwain*